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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,952	11/30/2001	Herbert Eichenauer	Mo6482/LeA 35,002	5049

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EXAMINER	
MULLIS, JEFFREY C	

ART UNIT	PAPER NUMBER
1711	

DATE MAILED: 03/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/997,952	EICHENAUER, HERBERT	
	Examiner	Art Unit	
	Jeffrey C. Mullis	1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 December 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10,12,13 and 18-44* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *27,43 and 44* is/are allowed.

6)☒ Claim(s) *1-10,12,18-26,28-34 and 39-42* is/are rejected.

7)☒ Claim(s) *13 and 35-38* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

TS

All previous rejections are hereby withdrawn.

The terminal disclaimer filed on 9-1-04 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US patent 6,727,319 has been reviewed and is accepted. The terminal disclaimer has been recorded.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-10, 12, 18-26, 28-34, 39-42 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 6716916. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent claims recite at lest one graft copolymer and in fact patent claim 3 even recites “at least two rubber lattices”.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 2, 6 - 10, 12, 18- 26, 2 8 -34 and 39 - 42 are rejected under 35 U.S.C. 102(b)as being anticipated by Sun et al. (WO 01/16230).

It is noted that Sun et al. corresponds to United States patent 6, 716, 916 as evidenced by the cover sheet of the US patent. As the United States patent is in English the United States patent will be referred and not the pct patent.

Sun et al. disclose a process in which bimodal polybutadiene latex is grafted with

styrene and acrylonitrile in applicants amounts. Since bimodal latex contains two rubber particles, one particle could be said to correspond to the rubber in applicants part " A" the other particle could be said to correspond to the rubber and applicants part " B" . Note that the particle diameters recited in example one correspond to applicants' particle diameters where diameters are recited. Note that the latex in example one is first grafted with peroxydisulfate and then in the presence of ascorbate and hydroperoxide, i.e. the second step corresponds to a redox reaction. Note claim one of the patent which discloses that the latex utilized has a glass transition of less than 0°C.

Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sun et al., cited above.

Sun et al. does not disclose any examples containing the specific amounts of monomers of claims 3-5 with the specific monomers in claims 3- 5. However column 4 lines 12 -- 20 of sun et al. specifically disclose use of such monomers amounts of

monomers recited in these claims. Hence it would've been obvious to a practitioner having an ordinary skill in the art at the time of the invention use applicants' amounts of monomers and applicants' monomers in the expectation of adequate results absent any showing of surprising or expected results.

Pivotto et al., United States patent 4, 822, 858, cited of interest discloses a process in which a latex is grafted with both peroxydisulfate and redox initiator. However as stated by applicant's attorney in the response of April 15,2004 "the claimed composition requires at least two such rubbers. Component A and component B, each of which entails grafted rubber having a glass transition temperature lower than 0°C". Pivotto et al. therefore does not meet the limitation of the claims in that applicants component A and component B are not one and the same and are at least two different materials.

Any inquiry concerning this communication should be directed to Jeffrey C. Mullis at telephone number 703 308 2820.

Jeffrey C. Mullis
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Art Unit 1711

JCM

2-22-05